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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

PATTERSON, MARIE D

ART UNIT

PAPER NUMBER

3728

DATE MAILED: 06/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/592,462

Applicant(s)

GRIM ET AL.

Examiner

Marie Patterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 May 2002 and 23 May 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-23 and 33-49 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-23 is/are allowed.
- 6) ☒ Claim(s) 33-49 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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Reissue Applications

1. The reissue Declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP 1414.
2. The reissue Declaration filed with this application is defective (see 37 CFR 1.175 and MPEP 1414) because of the following:

The original Declaration is not relevant to the newly filed claims.

3. It is noted that applicant has requested that the requirement for new Declarations be deferred until claim language is finalized and thus such a requirement is deferred and will be required when the claims are finalized.
4. It is noted that claims 33-49 should have been underlined entirely because they are newly added to the original patent. Any response to this office action should include an amendment showing all of these claims underlined.

Specification

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of 37 CFR 1.71(a)-(c):

- (a) The specification must include a written description of the invention or discovery and of the manner and process of making and using the same, and is required to be in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which the invention or discovery appertains, or with which it is most nearly connected, to make and use the same.

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(b) The specification must set forth the precise invention for which a patent is solicited, in such manner as to distinguish it from other inventions and from what is old. It must describe completely a specific embodiment of the process, machine, manufacture, composition of matter or improvement invented, and must explain the mode of operation or principle whenever applicable. The best mode contemplated by the inventor of carrying out his invention must be set forth.

© In the case of an improvement, the specification must particularly point out the part or parts of the process, machine, manufacture, or composition of matter to which the improvement relates, and the description should be confined to the specific improvement and to such parts as necessarily cooperate with it or as may be necessary to a complete understanding or description of it.

The specification is objected to under 37 CFR 1.71 because the specification, as originally filed, does not provide support for the invention as now claimed.

There is no basis in the original specification for sections “with the height of said sections being at least equal to the width thereof” as now claimed in claims 39, 42-44, and 48. As pointed out and argued by applicant in column 13 lines 34-37 of the Patent it is stated “the removable sections are resilient and each have a height that is greater than its width and depth”. This does not state or provide basis for the height to be equal to the width.

There is no basis in the original specification for “the height being sufficient that each section can sway laterally”, the only disclosure of means for allowing the section to sway is on column 13 lines 10-20 which states “the grid pattern of resilient sections creates a multiplicity of sections that sway laterally independently of one another”. There is no disclosure of a “height” that would be required for such or what heights would be “sufficient”. There is only basis for the “grid pattern” allowing the sections to sway.

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Claim Rejections - 35 USC § 112

6. Claims 33-49 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See above.

7. Claims 33-43, and 45-49 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 33, 36, 37, 38, 39, 43, 45, 48, and 49 the phrases “the height being sufficient that each section can sway laterally” is vague and indefinite and it is not clear what structural limitations applicant intends to encompass with such language, i.e. what height is considered to be sufficient. There is no guidance in the specification as to what height is considered to be sufficient.

In claim 39 the phrase “extends only part way up the heel and ankle” is confusing, vague, and indefinite and it is not clear what structural limitations applicant intends to encompass with such language.

In claims 42 and 43 the phrase “upper footgear surfaces for holding the foot into the footgear” is confusing, vague, and indefinite. How can a surface hold a foot? No structure as such as been disclosed. It is not clear what structural limitations applicant intends to encompass with such language. The argument that the inner surface of flaps hold the foot in the footgear is not

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persuasive because it is actually the flaps and securing means (46) which performs the function of holding the foot into the footgear and these structural limitations are absent. There is insufficient structure to perform the recited function in the claims.

In claim 48 the phrase “a linear extent less than 3/4 inch and being substantially equal to one-half inch” is alternative, contradictory and confusing. It is not clear what structural limitations applicant is actually claiming and positively reciting.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 33-38, and 47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kellerman in view of Andrews (4793078) and Moronaga (4633598).

Kellerman shows a pad/footgear comprising a flexible sheet (12 or an insert as discussed in column 8, lines 3-8) and removable resilient sections (34) forming a resilient layer substantially as claimed except for orienting the insert so that the removable resilient sections are an upper layer and making the inner sole sections from multiple layers. Andrews teaches providing an insert with removable resilient sections with the removable sections being the upper layer adjacent a wearer's foot to better relieve pressure at sensitive areas of a wearers' foot. Moronaga teaches forming an insole pad from three layers with progressively different softnesses. It would have been obvious

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to provide the inserts on the upper surface of the insole/pad as taught by Andrews and to make the insole from three different layers as taught by Moronaga in the pad/footgear of Kellerman to better relieve pressure at regions of swelling, pain, or inflammation (as discussed in Kellerman in column 6 lines 4-7) and to provide better shock absorption and cushioning and to conform the insole to "suit the user's requirements" (column 2 lines 21-22).

10. Claims 39, 42, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grim (5078128) in view of Kellerman and Andrews (4793078).

Grim shows a footgear comprising an outer sole (25), flaps and arrangement with an open toe (shown in figure 6), and an inner sole (200) substantially as claimed except for the exact inner sole. Grim suggests the use of customizing cushion construction in column 3 lines 42-45.

Kellerman teaches customizing cushion construction by providing a pad comprising a flexible sheet (12 or an insert as discussed in column 8, lines 3-8) and removable resilient sections (34) forming a resilient layer for relieving pressure at regions of swelling, pain, or inflammation (column 6 lines 4-7). Andrews teaches providing an insert with removable resilient sections with the removable sections being the upper layer adjacent a wearer's foot to better relieve pressure at sensitive areas of a wearers foot. It would have been obvious to provide a pressure relieving insert insole as taught by Kellerman and to provide the removable sections on the upper surface of the insert as taught by Andrews in the footgear of Grim to relieve pressure at sensitive areas of a patients foot and thereby customize the cushion for the specific patient.

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11. Claim 40 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 39 above, and further in view of Cavanagh (4608768).

Grim as modified above shows footgear substantially as claimed except for hook and loop fasteners on the bottom of the inner sole to connect it to the outer sole. Cavanagh teaches the use of hook and loop fasteners on the bottom of an inner sole to provide releasable secure connection of the inner sole to the footgear (column 4 lines 25-30). It would have been obvious to provide hook and loop fasteners as taught by Cavanagh in the footgear of Grim as modified above to provide secure and removable attachment for the inner sole.

12. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 39 above, and further in view of Moronaga (4633598).

Grim as modified above shows footgear substantially as claimed except for the inner sole being made from three layers. Moronaga teaches forming an inner sole from three layers with progressively different softness. It would have been obvious to make the inner sole sections from layers having different softness as taught by Moronaga in the footgear of Grim as modified above to provide better shock absorption and cushioning.

13. Claims 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kellerman in view of Andrews (4793078).

Kellerman shows footgear comprising a flexible sheet (12 or an insert as discussed in column 8, lines 3-8) and removable resilient sections (34) forming a resilient layer substantially as claimed except for orienting the insert so that the removable resilient sections are an upper layer.

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Andrews teaches providing an insert with removable resilient sections with the removable sections being the upper layer adjacent a wearer's foot to better relieve pressure at sensitive areas of a wearers' foot. It would have been obvious to provide the removable sections on the upper surface of the insole/pad as taught by Andrews in the footgear of Kellerman to better relieve pressure at regions of swelling, pain, or inflammation (as discussed in Kellerman in column 6 lines 4-7) and to provide better shock absorption and cushioning and to conform the insole to "suit the user's requirements" (column 2 lines 21-22).

14. Claim 46 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 42-45 above, and further in view of Cavanagh (4608768).

Kellerman as modified above shows footgear substantially as claimed except for hook and loop fasteners on the bottom of the inner sole to connect it to the outer sole. Cavanagh teaches the use of hook and loop fasteners on the bottom of an inner sole to provide releasable secure connection of the inner sole to the footgear (column 4 lines 25-30). It would have been obvious to provide hook and loop fasteners as taught by Cavanagh in the footgear of Kellerman as modified above to provide secure and removable attachment for the inner sole.

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Allowable Subject Matter

15. Claims 1-23 are allowed.
16. Claims 48 and 49 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

Response to Amendment

17. The Declaration filed under 37 CFR 1.132 filed 5/23/02 is insufficient to overcome the rejection of the claims based upon the references as set forth in the last and this Office action because:

In response to the previously filed Declarations and the arguments therein, the Declaration appears to provide arguments towards a rejection of Andrews as an anticipatory reference (which no such rejection has been made) or an obviousness rejection based on Andrews in view of Kellerman (which no such rejection has been made). Therefore, this Declaration is not persuasive since it is not directed towards the rejections that have been made in the prior office action and this office action.

In response to the arguments directed towards the removable sections swaying, there is no clear disclosure as to what height is considered sufficient and therefore there is no clear basis for such arguments. The cited phrase "The grid pattern...sway laterally" (paragraph 3 of the Declaration) appears to state that it is the "grid pattern" that provides the means for the swaying

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and there is no discussion of a required height. Even a low height would allow swaying to some degree.

In response to applicants' arguments directed towards the intended use of the insole, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

In response to applicants' arguments directed towards Andrews, Andrews has been applied as a modifying reference and clearly suggests providing a plurality of removable sections on the upper surface of an insole to provide the wearer with a means to adapt an insole to prevent pressure on sensitive areas of the foot. Andrews clearly suggests that it is desirable to allow the user to change the "number, shape, and position of the depressions" (column 2 lines 10-15). Kellerman clearly teaches providing an insert with a grid of removable section to reduce pressure in a desired area, it would have been obvious to modify the insert of Kellerman to have the removable sections on the upper surface as taught by Andrews to make the sections easier to modify and to better relieve pressure at regions of swelling, pain, and/or inflammation.

Response to Arguments

18. Applicant's arguments filed 5/13/02 have been fully considered but they are not persuasive.

In response to applicants' arguments directed towards the combination of Kellerman and Andrews, both Kellerman and Andrews teaches providing a thin top layer of material (18

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and/or 12). It would have been obvious to retain the use of the low friction type of material deemed desirable by Kellerman and still have the removable sections located on the upper surface of the insole as taught by Andrews. Also, it is noted that the use of the low friction material does not prevent the combination for meeting the claimed subject matter. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable.

Constant v. Advanced Micro-Devices Inc., 7 USPQ2d 1064.

In response to applicants' arguments directed towards the intended use of the Kellerman patent, Kellerman clearly states the intended use for "Foot diseases ranging from minor irritation, rashes, callouses, corns, bunions, and ingrown toe nails to more severe traumatic conditions....all of these traumatic conditions are aggravated by rubbing and abrasion" (see column 1 lines 15-24). Foot ulcers clearly fall into such a category of foot disease. Also, it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations.

In response to Applicant's argument that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgement on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the

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applicant's disclosure, such a reconstruction is proper. *In re McLaughlin*, 443 F.2d 1392; 170 USPQ 209 (CCPA 1971).

In response to Applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. *In re Nomiya*, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1971). references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek*, 163 USPQ 545 (CCPA) 1969. In this case, both Kellerman and Andrews are clearly directed towards insole/inserts with removable sections to reduce undesired pressure in specific areas to correspond to areas of sensitivity of a foot.

The Examiner has reviewed the case law cited by applicant, but finds the decisions and opinions expressed therein to be non-persuasive as to the non obviousness of the subject matter of the claims. "The question of obviousness however is so closely tied to the facts of each particular case, that prior decisions in cases involving different facts are ordinarily of little value in reaching a decision" (*In re Lainson*, 52 CCPA 880, 339 F2d 252, 144 USPQ 19 (1964)).

In response to applicants' arguments directed towards the reference Moronago, the exact method used to cut multiple layers is irrelevant and the arguments to cutting such with a blade

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being difficult is not persuasive because there are numerous other methods of making the separate sections that do not require cutting with a blade as described and argued by applicant, such as die cutting, laser cutting, separately molding, etc.

In response to applicants' arguments directed towards the height limitations, it is noted that there is no basis for the claimed limitations, see above rejections and objections.

In response to applicants' arguments directed towards turning the insert of Kellerman upside down, the Examiner is not suggesting such, in view of the teachings of Andrews, it would have been obvious to make the removable sections out of the upper surface and making the lower surface the base. This may result in one turning the insert upside down, but one would also be motivated to provide the low friction material on the upper surface as taught by Kellerman to retain the desired low friction surface.

Conclusion

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period

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will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

2. Telephone inquiries regarding the status of application or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the Examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148 or the Tech Center 3700 Customer Service Center number is (703) 306-5648.

For applicant's convenience, the Group Technological Center FAX number is (703)872-9302 Please identify Examiner____ of Art Unit ____ at the top of your cover sheet of any correspondence submitted. Please note that the Examiner is unable to confirm or deny receipt of Faxes.

Inquiries concerning the merits of the examination should be directed to Marie Patterson whose telephone number is (703) 308-0069.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g. copies of references cited, form PTO-1449, for PTO-892, etc. requests for copies of such papers should be directed to customer service at (703) 306-5648.

Check out our web-site at "www.uspto.gov" for fees and other useful information.



Marie Patterson
Primary Examiner
Art Unit 3728